APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,103	12/28/2001	Dhananjay V. Keskar	042390.P11136	2363

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Crystal D Sayles
Blakely Sokoloff Taylor & Zafman LLP
12400 Wishire Boulevard Seventh Floor
Los Angeles, CA 90025

EXAMINER
LE, BRIAN Q

ART UNIT	PAPER NUMBER
2621	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/041,103	KESKÅR ET AL.
	Examiner	Art Unit	
	Brian Q. Le	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>11 October 2005</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-4,6-13,15-20 and 22-30* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-4, 6-13, 15-20, and 22-30* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Response to Amendment and Arguments

1.   Applicant's amendment filed October 11, 2005, has been entered and made of record.

2.   The rejection of claims 7 and 22 under 35 U.S.C 11, first paragraph is withdrawn.

3.   Applicant's arguments with regard to claims 1-4, 6-13, 15-20, and 22-30 have been fully

considered, but are not considered persuasive because of the following reasons:

Regarding claim 1, the Applicant argues (page 3) that Lopresti Reference does not teach

the claimed elements of: "obtaining a scanned command mark written with a conventional

writing implement onto a conventional medium" and "recognizing the scanned command mark

as a command that may be executed by a processor, wherein the command mark is recognized

only the command mark is placed in the specified area of the medium." The Examiner

respectfully disagrees. Due to extremely broad claimed limitation, the claim is subjected to

reasonable interpretations. Furthermore, Lopresti clearly teaches, "obtaining a scanned

command mark (scans markers, abstract) written with a conventional writing (machine-readable

symbology) implement onto a conventional medium (document)". If the Applicant wishes the

Examiner to interpret the claim anything different than above, the Applicant should further claim

or explicitly claim in the claim language, for example, further specify the conventional writing

and convention medium. Also, Lopresti teaches the concept of "recognizing the scanned

command mark as a command (column 8, lines 33-36) that may be executed by a processor

(computer executes OCR software) (column 6, lines 20-28), wherein the command mark is

recognized only the command mark is placed in the specified area of the medium (command

marks will be recognized at a predetermined/predefined area such as machine area) (column 6,

lines 40-58 and column 8, lines 25-29)."

The Applicant also argues (top of page 4) that Lopresti only teaches marker is generated by computer and requires no human intervention. Again, the Applicant is arguing for limitations are not claimed in the claim's language. To further assist the Applicant with the guidance with claim language interpretations so that the Applicant can add further/more details limitations from the specification to the claims to overcome the prior arts, the Examiner is presenting MPEP, section 2111, Claim Interpretation; Broadest Reasonable Interpretation as follow: "The court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.")".

Thus, the rejections of all of the claims are maintained.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.   Claims 1-3, 5-12, and 14-30 are rejected under 35 U.S.C. 102(b) as being anticipated by

Lopresti et al. U.S. Patent No. 5,748,807.

Regarding claim 1, Lopresti teaches a method comprising:

"obtaining a scanned command mark (scans markers, abstract) written with a

conventional writing (machine-readable symbology) implement onto a conventional medium

(document)" (abstract); and

recognizing the scanned command mark as a command (column 8, lines 33-36) that may

be executed by a processor (computer executes OCR software) (column 6, lines 20-28), wherein

the command mark is recognized only the command mark is placed in the specified area of the

medium (command marks will be recognized at a predetermined/predefined area such as

machine area) (column 6, lines 40-58 and column 8, lines 25-29).

Referring to claim 2, Lopresti teaches the method wherein the command mark comprises

one of a operational mark (editing mark includes deletion and insertion marks) (column 10,

lines 16-49).

For claim 3, Lopresti also teaches the method wherein recognizing comprises:

recognizing a pattern associated with the command mark based on one of a statistical model

(probability/computation system) (column 5, lines 35-40 and column 9, lines 35-44).

For claim 6, Lopresti discloses the method further comprising obtaining secondary command marks written on the conventional medium, wherein the command mark is recognized before the secondary command marks are recognized as executable commands (The process of recognizing marker commands before text recognition by sequence processing/iteration) (FIG. 9, elements 70 and 71; column 12, lines 38-50).

Referring to claim 7, Lopresti shows the method wherein the medium includes printed text, and wherein when the recognized command mark is executed, the printed text is affected (column 10, lines 16-56).

Regarding claim 8, Lopresti teaches the method further comprising: executing the recognized command in the processor (Edit command/deletion/insertion recognized/processed by computer) (10, lines 16-56).

For claim 9, Lopresti also teaches the method further comprising: storing the recognized command in memory (stores processed/recognized command in computer) (FIG. 2, Computer System).

Regarding claims 10-12, and 14-17, please refer back to claims 1-3 and 5-9 for the teachings and the explanations.

Regarding claim 18, please refer back to claim 1 for the teaching and explanation. In addition, Lopresti teaches a machine-readable medium that stores machine-executable instructions for perform the claimed limitations (the computer and software) (FIG. 2, Computer System and OCR Software).

Regarding claims 19-24, please refer back to claims 2-3, 5, and 7-9 for further teachings and explanations.

For claims 25-28, please refer back to claims 1-2, 18 and 9 for the teachings and

explanations.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Henderson U.S. Patent No. 5,897,648 as applied to claim 2 above, and further in view of Berman

U.S. Patent No. 5,768,418.

Regarding claim 4, Henderson teaches the pattern recognition (recognized the edit

command) (column 2, lines 56-67). Henderson does not explicitly teach the application of

heuristic techniques to enhance accuracy of the pattern recognition. Berman further teaches a

handwriting command processing utilizing the heuristic techniques (column 3, lines 30-36 and

column 5, lines 40-45). Modifying Henderson's method of processing written command mark

according to Berman would able to utilize heuristic technique in pattern recognition to enhance

the accuracy. This would improve processing and therefore, it would have been obvious to one

of the ordinary skill in the art to modify Henderson according to Berman.

Regarding claim 13, please refer back to claim 4 for the teaching and explanation.

8.   Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Lopresti et al. U.S. Patent No. 5,748,807 and Henderson U.S. Patent No. 5,897,648.

Regarding claim 29, please refer back to claim 1 and 18 for the teachings and explanations.

Lopresti does not explicitly teach the method of obtaining stroke data and recognizing stroke

data. Henderson teaches a method of processing command marks (column 7, lines 15-26)

wherein the obtain stroke data that corresponds to the written command mark (digitizing and

scanning process) (column 2, lines 43-55), and recognize the stroke data as an executable

command (recognized the edit command and further provide the edited document) (column 2,

lines 56-67). Modifying Lopresti's method of processing command marks according to

Henderson would able to digitized edit format to editing document (column 2, lines 45-55). This

would improve processing and therefore, it would have been obvious to one of the ordinary skill

in the art to modify Lopresti according to Henderson.

For claim 30, Henderson further teaches the apparatus further comprising: a digital ink

detecting device which detects the command mark as stroke data (digitizer pen) (column 4, line

3-5).

Conclusion

8.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing
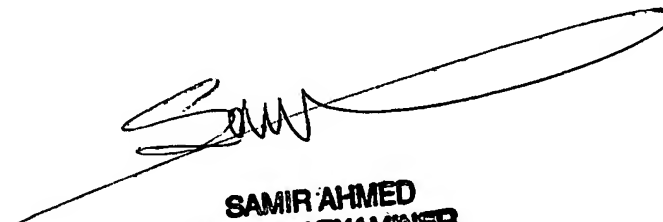
date of this final action.

Contact Information

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Brian Q. Le whose telephone number is 571-272-7424. The

examiner can normally be reached on 8:30 A.M - 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Mancuso can be reached on 571-272-7695. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BL
October 27, 2005

SAMIR AHMED
PRIMARY EXAMINER